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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,335	02/06/2004	Holger Fuchs	03020	4507

7590 01/30/2006  
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EXAMINER

ROBINSON, MARK A

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/772,335

Applicant(s)

FUCHS ET AL.

Examiner

Mark A. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 7-12, 14-24, 31-36 and 38 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-6 and 27-30 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 13, 25, 26, 37, 39 and 40 is/are rejected.
- 7) ☐ Claim(s) 41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,2,13,25,26,37,39 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Treace (US 3528720).

As discussed previously, Treace shows a drape system for a surgical microscope including a drape(35) and a holding device including a plastic (col. 4 line 50) holding unit(53) with a recess(63) for the main objective, the holding unit have a plurality of tongue-shape sections(55a) for applying a spring force onto the outer peripheral surface of the objective (col. 5 lines 13-17).

Regarding new claims 39 and 40, note that tongue-shaped sections(55a) will bend differently depending on the objective diameter since Treace teaches the function of these sections to accommodate objectives of different diameter.

***Allowable Subject Matter***

3. Claims 3-6 and 27-30 are allowed.

***Double Patenting***

4. Claim 41 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 3. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Response to Arguments***

5. Applicant's arguments filed 11/23/05 have been fully considered but they are not persuasive.

Applicant has argued that the sections(55a) of Treace are spline-like and not tongue-shaped as claimed.

However, in its broadest sense, the term "tongue-shaped" refers to a projection, protrusion, or rib-like structure (see either Webster's II New College Dictionary or Merriam-Webster's Collegiate Dictionary, 10<sup>th</sup> ed.). Items 55a of Treace clearly fit the broad definition of tongue-shaped since these items constitute projections or protrusions or rib-like structures.

Applicant has further argued that the function of these sections(55a) of Treace is different from that of the claimed tongue-shaped sections.

However, Treace explicitly teaches the function of sections(55a) to enable engagement with objectives of different diameters via resilient constriction of the sections on the outside of an objective. This is the same function as disclosed in the instant application, i.e. to apply a spring force (i.e. resilient constriction) onto the outer surface of the objective.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Robinson whose telephone number is (571) 272-2319. The examiner can normally be reached on 2nd Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
MARK A. ROBINSON  
PRIMARY EXAMINER

MR  
1/26/06